

## **Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.**

73 F. 3d 1573 (Fed. Cir. 1996)

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In 1992, Athletic Alternatives, Inc. ("AAI") filed a patent infringement claim against Prince Manufacturing, Inc. ("Prince") for its patent on a tennis racket design. Earlier, in August of 1988, AAI was granted a patent for the racket design, but in 1989 it was deemed anticipated by a British patent known as the Lewis patent. The patent examiner notified AAI that the patent would be allowable in spite of the anticipated claims if AAI rewrote the claims in independent form. AAI filed amendments to the original patent in October 1989 to remedy the anticipation issues. The patent examiner rejected some of the claim amendments on January 29, 1990 as they were clearly anticipated by the claim language in the Lewis patent. On April 17, 1990, the patent examiner issued his final rejection of the anticipated claims in the AAI patent and AAI appealed the rejection to the Board of Patent Appeals. Finally, in December, 1990, the patent examiner withdrew his rejection of the patent and issued a Notice of Allowability for AAI's racket design patent. The AAI patent was granted on August 6, 1991.

While involved in discussions and modifications with the patent board concerning the racket design patent, AAI entered into a confidentiality agreement with Prince in anticipation of a collaborative effort for racket design. Prince and AAI failed to reach an agreement amenable to both parties and Prince abandoned the model on which they collaborated to pursue an alternative design. As a result, in February 1991, Prince Manufacturing unveiled the "Vortex" racket, prompting AAI to file a patent infringement suit against Prince in January, 1992. Prince moved for summary judgment for noninfringement as the language of the AAI patent claims precluded the design utilized in the Prince racket on December 7, 1992 and summary judgment was granted on June 29, 1994. The court concluded that the AAI patent claims disallowed the design utilized by Prince and AAI was estopped from claiming that the Prince design infringed as a result of the doctrine of equivalents. Finally, the district court ruled that AAI did not provide the court with evidence that the racket design utilized by Prince performed the same functions in substantially the same way to obtain the same result as that specified in the AAI patent. AAI subsequently appealed the judgment to the Court of Appeals for the Federal Circuit.

The court determined that patent infringement analysis involves discerning the meaning and scope of a patent claim as well as a determination of whether or not the accused product infringes on the patent. In order to determine the meaning of the claims, the patent record must be analyzed, including the patent claims, specification and prosecution history when available. When definitions for claim language are not provided in the claims, the court must interpret the claim language with the ordinary meanings of the words used.

The court determined that the language of the AAI claim could be construed in two ways, one indicating infringement and one finding no infringement; therefore, the prosecution history of AAI's patent was reviewed. According to 35 U.S.C. § 112, patent specifications must include claims which distinctly cover the subject matter of the invention to prevent unreasonable advantages to a patentee and to provide others with appropriate notice as to the subject matter and scope of the patented invention. Furthermore, under the doctrine of equivalents, if an accused product differs from a patent claim, it may not literally infringe but may nevertheless infringe if the

differences between the inventions are insubstantial from the perspective of one with ordinary skill in the art. In order to prove infringement, the accused product must contain each item described in the patent claims for the patented invention and if a structure is excluded from the scope of the claims, the doctrine of equivalency may not allow the accused item to trigger infringement.

The Court of Appeals for the Federal Circuit concluded that the racket design in the AAI claim could not be deemed equivalent to the Prince racket under the doctrine of equivalency. The scope of the AAI claims excluded rackets such as the Prince Vortex and the court ruled that the district court was correct in granting summary judgment under the doctrine of equivalents. Accordingly, the district court's grant of summary judgment was affirmed.